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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John A. Miller Miller IP Group, PLC 42690 Woodward Avenue Suite 200 Bloomfield Hills, MI 48304			EXAMINER MCLELLAND, KIMBERLY KEIL	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 06/29/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/566,736

**Applicant(s)**

BROD ET AL.

**Examiner**

KIMBERLY K. MCCLELLAND

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-18 and 20-29 is/are pending in the application.
- 4a) Of the above claim(s) 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first and second measuring units and control device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0136503 to Green et al. in view of U.S. Patent No. 6,558490 to Klein et al.

5. With respect to claim 1, Green et al. discloses an RFID labeling apparatus, including a first device for outputting the at least one web material (500) at a predefined speed; a carrier belt (See paragraph 0023) for transporting the one or more transponder devices at the predefined speed; a control device (See paragraph 0089), which inherently includes a speed measuring unit for measuring the running speeds of the carrier and web; and a bonding device (ABD) for bonding the one or more released transponder devices to the at least one web material at the predefined speed; (See paragraphs 0089-0091 and Figure 10). However, Green et al. does not specifically disclose a first measuring unit and a second measuring unit.

6. Klein et al. discloses a label application system, including a first measuring unit for measuring a running speed of the carrier belt; a second measuring unit for measuring a running speed of the web material (72/74; Figure 2B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the measuring units taught by Klein et al. with the apparatus of Green et al. The motivation would have been to provide instant velocity comparisons during operation, ensuring effective alignment between the web and carrier (column 9, lines 6-16).

7. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114. The phrases, "continuous predetermined speed", and "for matching the running speeds of the carrier belt and the web material to the continuous predetermined speed" are considered intended use of the currently claimed apparatus.

8. As to claim 12, Green et al. discloses the bonding device comprises at least one unit for producing at least one of a soldering bond, an adhesive bond, a laser-welded bond, or an ultrasonic bond (See paragraph 0091).
9. As to claim 13, Green et al. discloses the carrier belt includes a belt (See paragraph 0023) for supporting the one or more transponder devices, and a supply unit for supplying the transponder devices to the belt (608).
10. As to claim 14, Green et al. discloses the supply unit comprises at least one unwinding roll (608). Examiner notes the phrase, "for measuring the speed of the carrier belt and the first device and for synchronizing the speed of the carrier belt with the speed of the first device" is considered intended use of the currently claimed invention. Consequently, this limitation is not found to structurally define the current invention.
11. As to claim 15, Green et al. discloses the bonding device comprises a curing unit for curing the bonds according to at least one of air, UV irradiation, laser irradiation, thermodes or electron beam irradiation (See paragraph 0091).
12. As to claim 16, Green et al. discloses a plurality of carrier belts and corresponding bonding devices that are positioned at predefined locations relative to the at least one web material (See paragraphs 0101-0103).
13. As to claim 18, Green et al. discloses the bonding device includes two rollers, the rollers rotate counter to each other and the carrier belt releases the transponder devices prior to being fitted to the at least one web material via the rollers (A/B; See Figure 10).

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0136503 to Green et al. in view of 6,558490 to Klein et al. as applied to claims 11-16 and 18 above.

15. With respect to claim 17, Green et al. discloses different methods of fitting the transponder devices to the at least one web material are equivalent (see paragraph 0091). Green et al. also discloses multiple transfer units may be used to transfer a series of rf components (See paragraphs 0101-0103). Green et al. does not specifically disclose the plurality of bonding devices perform two or more different methods of fitting the transponder devices to the at least one web material. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use bonding devices performing two or more different methods of fitting the transponder devices to the at least one web material, because the different bonding devices are known in the art to be equivalent. Simple substitution of one known bonding method for another would yield the predictable result of effectively bonding a plurality of rf components to a web.

16. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0136503 to Green et al. in view of U.S. Patent No. 6,558490 to Klein et al. as applied to claims 11-16 and 18 above, and further in view of U.S. Patent No. 6,280,544 to Fox et al.

17. Green et al. does not specifically disclose a wedge-shaped device having a surface configured to deflect the carrier belt at the predefined speed in a direction to

allow the release of the one or more transponder devices at a position defined by a section between the carrier belt and the at least one web material, thereby releasing each of the transponder devices at the end point of direction change of the belt.

18. Fox et al. discloses an application system, including a wedge-shaped device having a surface configured to deflect the carrier belt at the predefined speed in a direction to allow the release of the one or more transponder devices at a position defined by a section between the carrier belt and the at least one web material (46; See Figures 2 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the peeling wedge taught by Fox et al. for the peeling roller of Green et al. Simple substitution of one known peeling element for another would produce the predictable result of effectively removing RFID tags from a carrier. The motivation would have been to improve separation of the rf component from the rf sheetstock, improving production speed and efficiency.

19. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the



structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114. The phrase, "thereby releasing each of the transponder devices at the end point of direction change of the belt" is considered intended use of the currently claimed apparatus.

### ***Response to Arguments***

20. Applicant's arguments with respect to claims 11-18 and 29 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:

21. Applicant's arguments on pages 9-13 of the remarks filed 06/03/10 are primarily drawn to intended use of the currently claimed apparatus. Applicant is reminded claims 11-18 and 29 of the current application are drawn to an apparatus, not a method. The prior art only has to provide a structure that is capable of performing in the manner claimed and not necessarily have ever been intended to be used in this manner. As such, apparatus claim 11 requires a first and second measuring unit and a controller capable of operating at a continuous predetermined speed. It is the examiner's position that the structure of Green meets the limitations of the instant claims.

22. In response to applicant's argument that operation at a continuous predetermined speed is a structural limitation, rather than functional language, examiner disagrees. Examiner notes driving devices may be operated such that webs move continuously or intermittently. However, structurally, the apparatus remains unchanged despite operational speeds. Therefore, this argument is not persuasive.

Consequently, the newly added claim limitations of continuous predetermined speeds remain functional, not structural, features.

23. With regard to applicant's arguments against the function of the Green device, these arguments are not persuasive. Examiner notes claims 11-18 are apparatus claims, not method claims. It is well settled that the intended use of a claimed apparatus is not germane to the issue of the patentability of the claimed structure. If the prior art structure is capable of performing the claimed use then it meets the claim. *In re Casey*, 152 USPQ 235, 238 (CCPA 1967); *In re Otto*, 136 USPQ 459 (CCPA 1963).

The device of Green is capable of being operated such that devices travel at a predetermined speed, because no further structure is required to transport devices at the same speed as opposed to traveling at differing speeds. Consequently, the intended use of the currently claimed apparatus is not found to structurally distinguish over the prior art apparatus.

24. In response to applicant's arguments that the function of Green "teaches away" from the currently claimed apparatus, this argument is not persuasive. Examiner notes disclosing a different method of operation does not constitute teaching away from the structure of an apparatus. Green discloses the same structural features, and therefore does not criticize, discredit, or otherwise discourage the solution claimed...." In *re* *Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Consequently, this argument is not persuasive.

25. With respect to applicant's arguments regarding the pitch at which the antennas are arranged on the carrier sheet of Green, these arguments are not persuasive. The

antennas are considered the contents of an apparatus, not a structure of the apparatus itself. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

26. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM